## REMARKS (37 CFR 1.111)

Applicant has considered all points made by the Examiner in the Office Action and has incorporated Examiner's suggestions to ensure compliance with the applicable rules.

Applicant amended the claims to clarify the structure which the Applicant believes distinguishes the present invention over the cited references, to clarify the function of the claimed invention, and to clarify the limitations within the claims drawn to such a structure. However, such amendments have not been made to narrow the claims of the original application, but rather simply to clarify claims due to grammar that the Examiner found unclear. Applicant believes the amendments are supported in the specification.

1.     <u>Amendment for Clarity</u>

Applicant has amended Claim 11, lines 6-7, by moving the limitation "to be converted" to clarify that it is the records that are to be converted, not the database.

2.     <u>35 U.S.C. § 112 Rejection</u>

The Examiner has rejected Claims 10 and 11 pursuant to 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention because the Examiner believes there was insufficient antecedent basis for "said selected records." Applicant has amended Claims 10 and 11 by deleting "selected" in order to clarify that these limitations refer to the previously referenced (in the claims) "records." Applicant has amended Claims 10 and 11 as set forth above, not to narrow the claims of the original application, but simply to clarify the claims due to language that the Examiner found unclear.

3.     <u>35 U.S.C. § 102 Rejection</u>

Claims 1, 5, 9-11, 17, and 19 were rejected under 35 U.S.C. § 102(e) as being anticipated by Mezei (US 6,070,175); and Claim 12 was rejected under 35 U.S.C. § 102(e) as being anticipated by Warmus (US 6,332,149). Anticipation is a factual determination. In order to establish anticipation, it is incumbent upon the Examiner to identify in a single prior art reference disclosure of each and every

element of the claims in issue, arranged as in the claim. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 U.S.P.Q. 481 (Fed. Cir. 1984); In re Schaumann, 572 F.2d 312, 197 U.S.P.Q. 5 (C.C.P.A. 1978) (anticipation is measured with respect to the terms of the claims in issue).

When determining if a prior art reference anticipates a claim containing elements expressed as a means for performing a function pursuant to 35 U.S.C. § 112, last paragraph, "the limitations which must be met are those set forth in each statement of function." RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1445 n.5, 221 U.S.P.Q. 385, 389 (Fed. Cir. 1984).

When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, the reference does not anticipate. Akzo N.V. v. U.S. Int'l Trade Comm'n, 808 F.2d 1471, 1480, 1 U.S.P.Q.2d 1241, 1245-46 (Fed. Cir. 1986), cert. denied, 482 U.S. 909, 107 S.Ct. 2490 (1987).

Applicant respectfully traverses each of the rejected Claims. In regard to those claims rejected based upon Mezei, it should be understood what Mezei discloses (what the invention does) in contrast to Applicant's invention and the subject claims. Without limitation, Mezei discloses a method of filling in templates with blocks of information. In short, it provides auto-fill for forms. In contrast, Applicant's invention provides for complete control over the format and positioning of information in the output.

In regard to each of the rejected Claims 1, 5, 17, and 19, the Examiner equates the portion of the claims that states, "...an instruction to said pagination program directing how said pagination program will format said output;" and that portion of Claim 9 which claims, "...instructions to said pagination program to create a desired output;" to two (2) sections of Mezei. The first Mezei section is found at column 28, lines 55-65, and states:

> FIG. 51 is a flow-chart of ParagraphFormat which may be activated by choosing document report from a dialog box 905. The next step is to construct and display a list of current selected and cataloged paragraph formats 906. The next step is to get the user's format selection 907. The next step is to create a new document 908. The next step is to add a two-

column, sixty-two-row table 909. The next step is to add a title and a header text cell tab 910. The next step is to get the basic properties and add them to the table 911. the next step is to get the default font properties and add them to the table 912. The next step is to get the pagination properties and add them to the table 913. The next step is to get the numbering properties and add them to the table 914. The next step is to get the advanced properties and add them to the table 915. the next step is to get the table cell properties and add them to the table 916. The next step is to exit 917.

As disclosed above, the "control" of formatting exerted by a Mezei user is limited to the creation and filling of a "two-column, sixty-two-row table." In contrast, the Applicant's invention is not limited by a table output. The present invention allows for the output to be formatted as the user chooses and for information to be placed, individually not in blocks, anywhere on the output.

The second Mezei section is found at column 30, lines 13-22, and states:

The next step is to convert the CGM file to MIF format in a temporary MIF file 974. The next step is to import the MIF file into an anchored frame 975. The next step is to group all objects in an anchored frame 976. The next step is to determine if a text frame was created 977. If a text frame was created in step 972 then set the frame parent of the group to page format 978. The next step after step 978 is to delete the text frame 979. The next step after step 979 or the next step after step 977 if no text frame was created in step 972 is to remove the temporary MW file 980. The next step is to exit 981.

This passage is directed toward an anchored frame. It adds no disclosure relevant to the formatting and text placement capabilities of Applicant's invention.

Similarly, Claims 10 and 11 include, "...instructions to said pagination program to create a desired output;" to which the Examiner cites Mezei at column 6, lines 6-17, which states:

II. Database Publishing

The present invention improves upon the database publishing capability of FrameMaker.RTM. by adding the capability to dynamically integrate documents with database systems, handle complex database schemas, handle complex FrameMaker.RTM. templates in which an information field's size and position are not fixed, combine database columns, combine database rows, select database rows, and navigate database rows. This improvement to FrameMaker.RTM. is in the form of a C language program called DBPublish. This program may be found in the microfiche appendix to the present invention.

This portion of the Mezei disclosure is a general statement regarding database publishing into a template. The template (as later more specifically described as a "two-column, sixty-two-row table") does not provide the flexibility that Applicant's invention does.

In regard to those claims rejected based upon Warmus, it should again be understood what Warmus discloses (what the invention does) in contrast to Applicant's invention and the subject claims. Without limitation, Warmus discloses a system and method of reproducing images by filling in a template with, not only blocks of information, but entire pages of data. Warmus is designed to apply to publishing existing pages and books, not created newly formatted pages with each run as is Applicant's invention. Again, Applicant's invention provides for complete control over the format and positioning of information in the output.

The rejected Claim 12 includes, "...using said file template to add a field directive to said record of said first product, said field directive containing instructions used by said pagination program for formatting an output;" to which the Examiner cites Warmus at column 12, lines 48-62, which states:

> The database 108 is assembled by creating an ASCII file having a plurality of records wherein each record includes one or more fields entered into the database in tab-delimited format (i.e., the fields are separated from one another in each record by tab keystrokes and the records are separated from one another by line returns) and wherein the fields are arranged under field names of a header. Each field may include text to be reproduced on a page or a name of an image file stored in the memory 53 and defining an image to be reproduced on a page.
>
> In addition to the foregoing data, the database 108 may include an optional field designating the number of copies of each book to be produced, an optional townsort image field, a version identification field indicating book version number if multiple book versions are to be produced, an optional distribution list field, control data and the like.

As stated above, this disclosure refers only to publishing a page of text or an image. The optional field may designate the number of copies of each book to be produced, but the formatting and page placement of the data is already set. This is unlike the Applicant's invention.

Therefore, without limitation, Mezei does not disclose each of the elements of Claims 1, 5, 9-11, 17, and 19; nor does Warmus disclose each of the elements of Claim 12. Thus, neither patent cited by the Examiner discloses each and every element of the claims at issue.

4.    35 U.S.C. § 103(a) Rejections

Pursuant to 35 U.S.C. §103(a), the Examiner has rejected Claims 2, 6, 18, and 20 on the basis that such claims are unpatentable over Mezei, (U.S. Patent No. 6,070,175) in view of Sutcliffe, (U.S. Patent No. 6,253,216).

The cited disclosures are unrelated to Applicant's disclosure and claims. That is, they inherently teach away from Applicant's invention. The functionality described in Mezei is to provide an application for the manipulation of databases. While the functionality described in Sutcliffe is to provide a "personals" dating service using personalizable web-pages based on existing templates. As a result, these references cannot be combined, in that neither patent suggests the use of the other. It is incorrect to compare the art of Mezei with the art of Sutcliffe because they are directed at different inventions, purposes, goals, and are otherwise unrelated. In no way does this suggest or teach Applicant's invention.

All of the elements of Claims 2, 6, 18, and 20 are not disclosed nor suggested by the references. The Examiner admits that Mezei does not disclose several limitations (listed in the office action) shared by Claims 2, 6, 18, and 20, but asserts that this subject matter is disclosed by Sutcliffe. Applicant respectfully disagrees, and again points out the differences in the purpose and use of Applicant's invention and that disclosed by Sutcliffe.

The first limitation identified by the Examiner as being disclosed in Sutcliffe is identifying a first recipient of the output. The Examiner points to Sutcliffe col. 3, lines 64-65 for this disclosure. However, Sutcliffe discloses a situation where a customer supplies their name to an operator in order to begin the process of customizing the customer's personals ad. In other words, a potential customer calls the company using the Sutcliffe system and talks with an operator who logs takes the potential customer's name. In contrast, this limitation in Applicant's invention regards the retrieval, by the computer

application, of a possible recipient's name. This information is already stored by Applicant's system, it is not being taken for the first time. The identifying is being done by the system rather than an individual. And, the customer of Sutcliffe is the person who is taking out the ad (the seller), not a client who may buy product as with Applicant's system (the buyer). Sutcliffe does not take the recipient's information.

The second limitation identified by the Examiner as being disclosed in Sutcliffe is obtaining the first recipient's address information. The Examiner points to Sutcliffe col. 4, lines 1-5 for this disclosure. The differences in regard to this limitation are the same as for the above.

The third limitation identified by the Examiner as being disclosed in Sutcliffe is determining if the first recipient has at least one listed characteristic: a bad account, a closed account, a competitor, a prior recipient, a non-orderer, or an undesirable physical location. The Examiner points to Sutcliffe col. 10, lines 32-37 for this disclosure. However, there is no such characteristic disclosed by Sutcliffe. At the cited reference point, Sutcliffe describes keeping track of certain information, namely last date viewed, number of times viewed, and whether the page has been edited since last being viewed. Thus, Sutcliffe's system contemplates a simple counter, or counters, to count occurrences, and nothing more. The listed limitation in Applicant's system is not a counter at all. Instead, it is a listing of information regarding the customer that may be used by the system to make a determination of whether to send the output to that customer

The forth limitation identified by the Examiner as being disclosed in Sutcliffe is terminating transfer of the output to the first recipient if the first recipient has one or more of the listed characteristics. The Examiner points to Sutcliffe Fig. 4, ref. 166, and corresponding text at col. 10, lines 47-62 for this disclosure. The disclosed "remove permission" in Sutcliffe is not similar to Applicant's send determination. Sutcliffe allows for a user (the personal ad placer) to direct that other specific reviewers cannot view the user's personal ad. This is accomplished by direct action of the user with the system only making it possible. In contrast, Applicant's claimed limitation involves a determination of who to send the output to by the system itself.

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The fifth limitation identified by the Examiner as being disclosed in Sutcliffe is transferring the output to the first recipient if the first recipient does not have said characteristic. The Examiner points to Sutcliffe Fig. 4, ref. 168, and corresponding text at col. 10, lines 15-21 for this disclosure. However, much as above, Sutcliffe contemplates "permission" being granted by the user, while Applicant's system itself determines whether to send the output to the subject recipient.

For these reasons, without limitation, Applicant believes Claims 2, 6, 18, and 20 are patentable over Mezei and Sutcliffe.

## CONCLUSION

In view of the above, it is submitted that the remaining claims are in a condition for allowance. Reconsideration and withdrawal of the rejections and objections are hereby requested. Allowance of the pending claims at an early date is solicited.

If impediments to allowance of the pending claims remain, and a telephone conference between the undersigned and the examiner would help remove such impediments in the opinion of the examiner, a telephone conference is respectfully requested.

Respectfully submitted,

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